UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,983	06/09/1999	ANDERS R. WALLGREN	EFIM0346	7582

31408 7590 11/08/2006		EXAMINER
LAW OFFICE OF JAMES TROSINO		GARG, YOGESH C
92 NATOMA STREET, SUITE 211		
SAN FRANCISCO, CA 94105	ART UNIT	PAPER NUMBER
	3625	

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 September 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>23-38</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>23-38</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The applicant's Request for reconsideration received on 9/7/2006 is acknowledged and

entered. Claims 23-38 are pending for examination.

Response to Arguments

2.1.   Applicant's arguments, see Remarks, pages 2-3, filed 9/7/2006, with respect to 132 (a)

Objection and 112, first paragraph rejection have been fully considered and are persuasive. In

the earlier Office action mailed on 6/2/2006, the examiner interpreted the limitation, " selectively

displaying to the user the modified instances of the object individually or collectively " as

displaying selected modified instances whereas the applicant, in his remarks filed on 9/7/2006,

has clarified that the selection is done with respect to allowing the customer to view the modified

instances individually or collectively and that the selection is not related to selecting from the

modified instances. In view of this clarification, the 132 (a) Objection to specification and 112,

first paragraph rejection of claims 23-38 have been withdrawn.

2.2.   Applicant's arguments see Remarks, pages 8-9, filed 9/7/2006, with respect to

Giovannoli reference have been fully considered and are persuasive. In view of the applicant's

arguments the examiner's suggestion that claims 23 and 31 are obvious in view of Giovannoli is

withdrawn.

2.3.   ·Applicant's arguments (see Remarks, pages 3-8) filed with respect to rejection of

independent claims 23 and 31 under 103 (a) as being unpatentable over the combined arts of

Thackston/Hill/Huberman have been fully considered but they are not persuasive for following

reasons:

        The applicant argues that Thackston does not describe or suggest systems and

methods receiving a user supplied set of constraints regarding a print job project. In response to

applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) because the limitations of claims 23 and 31 are rejected as being unpatentable over the combined arts of Thackston/Hill/Huberman which does disclose system and method being used for contracting print-jobs. It is to be noted that the system and method, as disclosed in the applicant's disclosure, see pg.5, lines 1-9, is applicable for contracting any custom project which, for example could be a print-project. The applicant's invention as disclosed is not solely dedicated to contracting print-job projects. In fact, it is one of the intended uses of the applicant to use the system for contracting a print-job project and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the present case, the combined prior art of Thackston/Hill/Huberman is capable of performing the intended use as analyzed in the earlier Office action and therefore it meets the claims 23 and 31.

The applicant argues that Thackston does not disclose the limitations, " storing the set of constraints in a database as an object, creating a plurality of instances of the object, each instance uniquely associated with a corresponding vendor " because in Thackston the templates are not user supplied constraints but are rather user supplied terms stored in contracts data module 696 and if it is accepted the templates are user supplied constraints stored as objects then Thackston does not disclose vendor specific copying of the contract plates and communicating each unique instance of the templates to its corresponding associated vendor. The examiner respectfully disagrees. Thackston does teach using web browser templates to

submit RFQ form and the RFQ form includes constraints, such as quantity requirements,

schedule requirements, delivery requirements, date and time of bidding enabling vendors to bid

and negotiate the terms and conditions to and fro (see at least col.50, line 31-col.51, line 48,

col.13, lines 1-25 and col.25, lines 25-58). In response to receiving the user's RFQ with a set of

constraints vendors responses and iterative responses during negotiations to arrive at an

agreed data relating to specifications, schedules, delivery requirements, bids, etc. correspond to

creating a plurality of instances wherein each instance is uniquely associated with a

corresponding vendor. Thackston discloses that such RFQ forms/templates are stored as

objects in an object-oriented database see at least col.6, lines 50-53 and col.43, lines 33-38.

Thackston's disclosure of negotiation process would have taught and fairly suggested the

claimed iterative plurality of customer submissions instances and vendor responses instances

communicating them back and forth to clarify the terms and parameters of the goods and/or

services.

The applicant further argues that Thackston does not disclose the limitation "receiving

communications from the user and the vendors to iteratively modify the instances of the object,

the modifications further constraining the print job project", see Remarks pages 5-6. The

examiner does not agree. Thackston discloses conducting negotiations by using a series of

contract templates as a starting point for contractors and suppliers and different terms and

conditions for creating an agreement (see Thackston col.13, lines 1-25). The " Plain Meaning "

of the term" negotiations" used in Thackston is interpreted by the examiner as conducting to and

fro discussions between two parties that is between contractors and suppliers in order to reach

an agreement or sign a contract (see page 503 of Webster's New World Thesaurus, Revised

Edition Copyright © 1985 Simon & Schuster, Inc, NY. See Appendix A.). Thesaurus defines that

the term "negotiate" is synonymous with making arrangements to bargain, or transact or confer

or settle. The terms bargaining/transacting/settling implies to carry out to and fro or repetitive discussions between the two parties to settle/reach an agreement wherein every time one party submits some terms for acceptance by the other and the other party, in response, makes changes to the terms submitted by the first party and this process goes on till a settlement is reached between the two. If this repetitive process of submissions and responses do not work out into an agreement it is then called that the negotiations have failed. For example, a contractor, in response to a vendor's bid may modify the quoted terms by reducing the price, changing the specifications of the material or demanding an improved delivery. In response, the vendor, instead of accepting the contractor's offer, further makes changes in the customer's proposed offer trying to reach a middle ground. This process can continue till both the parties either agree to certain terms and conditions to make a contract or realize that they cannot reach an agreement. If the parties are able to make a contract then it is said that negotiations resulted into an agreement and if the parties do not make an agreement then it is said that negotiations failed to reach an agreement. The negotiation process of such repetitive discussions between parties to reach an agreement correspond to "a plurality of iterative customer submission instances and vendor response instances and " an iterative process in which one or more constraints on one of the vendor specific instances of the print job request object are added, removed and /or modified during each iteration" in claims 23 and 31. Note: In the above example, every time when a contractor or supplier, in response to each other, makes changes to each other's submission by making changes in the price or demanding a new improved delivery or a change in the material's specification or adding additional terms in the negotiation process corresponds to adding removing or modifying the constraints. If there were no changes/modifications ten there should not be any more negotiation since the parties have a meeting of the minds and could then enter into a contract.

The applicant argues, see Remarks, page 6, that Thackston does not teach the limitation, "selectively displaying to the user the modified instances of the object individually or collectively". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) because the limitations of claims 23 and 31 are rejected as being unpatentable over the combined arts of Thackston/Hill/Huberman which does disclose system and method selectively displaying the vendor's responses, that is instances individually or collectively as desired and analyzed in the earlier office action mailed on 6/2/2006.

The applicant argues, see Remarks, page 6, that Huberman does not teach the limitations recited in claims 23 and 31. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller,* 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) because the limitations of claims 23 and 31 are rejected as being unpatentable over the combined arts of Thackston/Hill/Huberman which does disclose system and method as claimed in claims 23 and 31 and analyzed in the earlier office action mailed on 6/2/2006.

The applicant's arguments, see Remarks, pages 6-7, are analyzed and not found persuasive based on the same rationale as used above against the applicant's arguments against the cited reference Huberman.

In view of the foregoing, rejection of claims 23-38 is sustainable as submitted in the

earlier Office action on 6/2/2006.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to
> a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

Claims 23-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Thackston, in view of Hill, and further in view of Huberman.

With regards to claim 23, Thackston teaches a computer-based contracting method

comprising:

receiving a user-supplied set of constraints regarding a job project; storing the set of

constraints in a database as an object; creating a plurality of instances of the object, each

instance uniquely associated with a corresponding vendor; communicating each instance of the

object to its corresponding associated vendor; receiving communications from the user and the

vendors to iteratively modify the instances of the object, the modifications further constraining

the job project; selectively displaying to the user the modified instances of the object individually

or collectively; and receiving a selection from the user of one of the vendors to complete the job

project (see at least, col.3, line 64-col.6, line 35, col.8, lines 45-57, col.8, line45-col.13, line 25,

col.15, line 28-col.16, line 4, col.17, line 34-col.25, line58, col.48, line 26-col.52, line17, FIG.2,

FIG.3, " 394-EC Data", FIG.4, " 415-Contracts between prime contractors and suppliers Data

module ", FIG.6, "394-EC Data", FIG.8,"890-Stored Time Multimedia Communications Sessions

Data Module", FIG.9, " 988-Electronic Commerce Processing Module", FIG.10, " 1004-Contracts

Module", FIG.12, FIG.13, " 1306 –Quasi-Real-Time Graphics Processing Module", FIG.14, "

988-Electronic Commerce Processing Module ", Figs 26-28. Note: "templates" [col.13, lines 11-

16, col.25, lines 25-58] correspond to request object and the changes made/negotiated/

formalized during interactive communication processing with suppliers/vendors [col.24, line 28-

col.25, line 25, col.8, lines 45-58] corresponds to vendor specific instances of a job request in

the application. At least, col.50, lines 43-65, " The RFQ may include information pertaining to

how many rounds of bids will be considered...", disclose series of iterative customer

submissions and vendor responses. Col. 48, lines 26-43 disclose that the RFQ subject matter

required by the user, that is prime contractor in Thackston, is stored in the form of a part design

model and this object of part design model is communicated to qualified vendors [fabricators].

Further, see col.49, lines 3-13 discloses that based upon the bids received from the qualified

vendors [fabricators] the user is able to select one or more vendors to complete the job and that

also implies that the vendor's responses are displayed on the GMR 2600 machine).

Please also note the following comments reproduced from the above cited response to

the applicant's arguments:

Thackston teaches using web browser templates to submit RFQ form and the RFQ form

includes constraints, such as quantity requirements, schedule requirements, delivery

requirements, date and time of bidding enabling vendors to bid and negotiate the terms and

conditions to and fro (see at least col.50, line 31-col.51, line 48, col.13, lines 1-25 and col.25,

lines 25-58). In response to receiving the user's RFQ with a set of constraints vendors

responses and iterative responses during negotiations to arrive at an agreed data relating to

specifications, schedules, delivery requirements, bids, etc. correspond to creating a plurality of

instances wherein each instance is uniquely associated with a corresponding vendor. Thackston

discloses that such RFQ forms/templates are stored as objects in an object-oriented database see at least col.6, lines 50-53 and col.43, lines 33-38. Thackston's disclosure of negotiation process would have taught and fairly suggested the claimed iterative plurality of customer submissions instances and vendor responses instances communicating them back and forth to clarify the terms and parameters of the goods and/or services . Thackston discloses conducting negotiations by using a series of contract templates as a starting point for contractors and suppliers and different terms and conditions for creating an agreement (see Thackston col.13, lines 1-25). The term "negotiate" is synonymous with making arrangements to bargain, or transact or confer or settle. The terms bargaining/transacting/settling implies to carry out to and fro or repetitive discussions between the two parties to settle/reach an agreement wherein every time one party submits some terms for acceptance by the other and the other party, in response, makes changes to the terms submitted by the first party and this process goes on till a settlement is reached between the two. If this repetitive process of submissions and responses do not work out into an agreement it is then called that the negotiations have failed. For example, a contractor, in response to a vendor's bid may modify the quoted terms by reducing the price, changing the specifications of the material or demanding an improved delivery. In response, the vendor, instead of accepting the contractor's offer, further makes changes in the customer's proposed offer trying to reach a middle ground. This process can continue till both the parties either agree to certain terms and conditions to make a contract or realize that they cannot reach an agreement. If the parties are able to make a contract then it is said that negotiations resulted into an agreement and if the parties do not make an agreement then it is said that negotiations failed to reach an agreement. The negotiation process of such repetitive discussions between parties to reach an agreement correspond to "a plurality of iterative customer submission instances and vendor response instances and " an iterative

process in which one or more constraints on one of the vendor specific instances of the print job request object are added, removed and /or modified during each iteration" in claims 23 and 31. Note: In the above example, every time when a contractor or supplier, in response to each other, makes changes to each other's submission by making changes in the price or demanding a new improved delivery or a change in the material's specification or adding additional terms in the negotiation process corresponds to adding removing or modifying the constraints. If there were no changes/modifications ten there should not be any more negotiation since the parties have a meeting of the minds and could then enter into a contract.).

Applicant's disclosure (page 5, lines 1-9) teaches that his invention is applicable for a custom manufacturing project and a print job can be an example. As per the disclosure, the invention is not directed to print job only. Though Thackston's embodiment is related to an electronic commerce application for finalizing suppliers for an engineering project, he further teaches that other embodiments and uses of his invention are apparent to those having ordinary skill in the art as the same steps and system elements would be applicable for other applications. Thackston's steps and system elements can be applicable to a print job also. In the same field of e-commerce, Huberman teaches a system and method to enable ordering and negotiating a print job on an electronic network (col.2, line 54-col.7, line 31). In view of Huberman, it would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Thackston to combine Huberman's feature of ordering and negotiating a print job on an electronic network. Doing so would enable the system to create an electronic marketplace and bidding system where the buyers and suppliers could interactively negotiate/formalize specifications via templates of the job as explicitly disclosed in Thackston and provide open and efficient pricing practices for ordering print jobs on electronic networks as suggested in Huberman (col.2, 54-63). Thackston/Huberman does not disclose displaying

vendor specific instances in a combined view, that is collectively. However, Hill explicitly

teaches comparing vendor specific instances in a combined view, that is collectively (see at

least abstract, FIG.9, FIG.13, col.8, line 53-col.10, line 29). In view of Hill, it would have been

obvious to a person of an ordinary skill in the art at the time of the invention to modify

Thackston/Huberman to combine Hill's feature of comparing vendor specific instances in a

combined view that is collectively. Doing so would enable the buyer to view two different images

corresponding to two or more different vendors' quotes frames side by side and thus making

comparison convenient and faster as explicitly discussed in Hill.

Regarding claims 24-26, it is already analyzed in claim 23 that Thackston/Huberman/Hill

receives a request for a print job. Thackston further discloses that the set comprises a text

description of the print job project/ a list of vendors to whom the instances of the object should

be communicated/ a due date for the print job project (see at least col.50, lines 44-65 where,

narrative description in the RFQ refers to "Text", delivery requirements in the RFQ refers to " a

due date for print job project" and " listing of qualified fabricators" in the RFQ refers to. The list

of vendors to whom the created RFQs, that is the vendor instances, be sent.).

Regarding claims 27-28 and 30, Thackston/Huberman/Hill discloses negotiations

between the user and a plurality of vendors to enable the user to select a winning vendor as

analyzed in claim 23. Thackston also discloses that the modifications comprise vendor-specified

options for completing the print job project such as start times or dates or pricing options (see

col.3, lines 22-49 which discloses that the negotiations with vendors include changes in the

designs of items being ordered, their delivery requirements and costing and that implies that the

vendor would negotiate all these changes including start times or dates and pricing options) .

Regarding claim 28, Thackston/Huberman/Hill discloses negotiations between the user and the a plurality of vendors to enable the user to select a winning vendor as analyzed in claim 23. Thackston also discloses that the vendor-specified options comprise media options (see Figs. 13 and 27-28 and col.49, line 46-col.50, line 65).

Regarding claims 31-38, their limitations are closely parallel to the limitations of claims 23-30 and are therefore analyzed and rejected on the basis of same rationale.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i)   US Patent 5,835,712 to DuFresne (see at least Abstract, col.19, line 50-col.20, line 37, figs.17-18 disclose conducting a web session in a client-server architecture using templates in the form of web forms to create a plurality of instances to and fro between the client and server by changing the states both by the client and server.

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
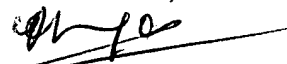
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
11/4/2006